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10/541,694	08/05/2005	Thomas Levy	Q88874	1929
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SUGHRUE MION, PLLC			NEURAUTER, GEORGE C	
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037			2143	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/541,694	LEVY ET AL.	
	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 July 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 08 July 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07082005</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claims 1-12 are currently presented and have been examined.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. This application is a national stage application filed under 35 USC 371.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 8 July 2005 was filed before the mailing of an action on the merits. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show in detail the elements as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because the abstract contains erroneous text such as “Fig. 1”. Correction is required. See MPEP § 608.01(b).

The specification is also objected to since the specification at page 7, line 25 and page 8, line 9 lists a prior art document as “EP-A-1 204 246”. A search by the Examiner at the European Patent Office revealed no such document by this number. The Applicant is requested to correct the number as shown in the specification and, if possible, provide the prior art document for proper consideration by the Examiner.

Claim Objections

Claims 1-12 are objected to because of the following informalities:

Claims 1-12 contain reference numbers that are assumed to correspond to the submitted figure. This extraneous information should be deleted as antecedent basis issues may arise from the use of substituting numbers for element names.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-12 recite a “method” in the preamble. It is unclear as to which statutory category of invention (e.g., system, method, or apparatus) these claims are within.

Claims 8 and 10-12 contain antecedent basis issues that arise from improper claim dependency (e.g. claim 8 should depend from claim 7 instead of claim 6 since claim 6 contains proper antecedent basis for the elements in claim 8) and therefore are indefinite.

Claims 11-12 recite “when the control unit comprises...means”. This limitation should be “signaling control unit” for the purposes of clarity. Also, it is unclear why such a limitation is required since it has been previously recited that the unit comprises such means and therefore introduces an ambiguity as to whether the means are actually part of the signaling control unit.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art ("AAPA") in view of "Distributed Code Caching for Active Networks" ("DAN").

Regarding claim 1, "AAPA" disclosed an active telecommunications network comprising:

an active node (11) comprising active code reception means and an active code execution environment (see page 2, lines 11-15 and 23-26 of the specification; note that if the active node is able to execute active code, it must have an active code execution environment); and

a signaling control unit (3) (see at least page 1, lines 5-13 of the specification) comprising:

means for receiving a request (5) to set up a virtual circuit between a client terminal (1) and a server terminal (2); virtual circuit set-up means (see at least page 1, lines 5-24, wherein the signaling control unit may be a SIP proxy, which is known to set up virtual circuits for a

communication session between a client and server; see also Applicant's admitted prior art "Session Initiation Protocol", the "standard" described in the specification being "RFC 2543", which has been cited in this Office Action).

Applicant's admitted prior art did not expressly disclose wherein the signaling control unit contains means controlled by the virtual circuit set-up means for sending active code to the active node, however, the Applicant did admit that the prior art disclose wherein active nodes receive active code in response to setting up a virtual circuit between a client and a server (see at least page 2, lines 23-37 and page 3, lines 1-3)

"DAN" disclosed a unit that sends active code to an active node upon a request to set up a virtual circuit between a server and a client analogous to the situation described in the Applicant's admitted prior art (see at least page 611, left column).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the means for sending active code to an active node within the signaling control unit described in "AAPA" since the combination would provide a system that takes advantage of the active network paradigm as described in both the Applicant's admitted prior art and "DAN" for virtual circuit applications such as those also described in both "AAPA" and "DAN" and one of ordinary skill, based on their analogous disclosures, would have expected the combination to be successful.

Regarding claims 2-4, "AAPA" and "DAN" disclosed a network according to claim 1. "AAPA" did not expressly disclose a network characterized in that the signaling control unit further comprises an active code library; means for selecting active code in the library, active code compilation means, and means for generating active code on the fly, however,

“DAN” did disclose these limitations (see at least page 611, left column, specifically regarding the steps described in Figure 2)

Claims 2-4 are rejected since the motivations regarding the obviousness of claim 1 also applies to claims 2-4.

Regarding claim 5, “AAPA” and “DAN” disclosed a network according to claim 1.

“AAPA” disclosed wherein the network is adapted to use the Internet Protocol (IP). (see at least page 1, lines 14-17)

“DAN” similarly discloses such a limitation (see at least page 610, left column, specifically “...common network layer protocol (typically IP)...”; see also references to the IP protocol throughout the reference)

Regarding claim 6, “AAPA” and “DAN” disclosed a signaling method for use in a telecommunications network according to claim 1.

“AAPA” did not expressly disclose sending an appropriate active code from the signaling control unit (3) to the active node (11), however, the Applicant did admit that the prior art disclose wherein active nodes receive active code in response to setting up a virtual circuit between a client and a server (see at least page 2, lines 23-37 and page 3, lines 1-3)

“DAN” disclosed a unit that sends an appropriate active code to an active node upon a request to set up a virtual circuit between a server and a client analogous to the situation described in the Applicant’s admitted prior art (see at least page 611, left column).

Claim 6 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 6.

Regarding claim 7, “AAPA” and “DAN” disclosed a method according to claim 6.

“AAPA” did not expressly disclose a step prior to the sending step of deciding on a strategy for sending of the appropriate active code by the signaling control unit, however, “DAN” disclosed that the active code is selected based on the function required before being sent to the active node (see at least page 611, left column).

Claim 7 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 8, “AAPA” and “DAN” disclosed a method according to claim 6.

“AAPA” did not expressly disclose a step prior to the sending step and optionally prior to the strategy decision step of the signaling control unit determining the appropriate active code, however, “DAN” disclosed that the active code is selected based on the function required before being sent to the active node (see at least page 611, left column).

Claim 8 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 9, “AAPA” and “DAN” disclosed a method according to claim 8.

“AAPA” disclosed a step prior to the determination step of negotiation between the terminals and the signaling control unit (3) of the characteristics of a communications session. (see at least page 1, lines 5-24, wherein the signaling control unit may be a SIP proxy, which is known to set up communication sessions including the characteristics for a communication session between a client and server; see also Applicant’s admitted prior art “Session Initiation Protocol”, the “standard” described in the specification being “RFC 2543”, which has been cited in this Office Action).

Regarding claim 10, “AAPA” and “DAN” disclosed a method according to claim 6. “AAPA” disclosed a step prior to the negotiation step of the signaling control unit receiving the virtual circuit request (5) and setting up the virtual circuit. (see at least page 1, lines 5-24, wherein the signaling control unit may be a SIP proxy, which is known to set up virtual circuits for a communication session between a client and server; see also Applicant’s admitted prior art “Session Initiation Protocol”, the "standard" described in the specification being "RFC 2543", which has been cited in this Office Action).

Regarding claim 11, “AAPA” and “DAN” disclosed a method according to claim 8.

“AAPA” did not expressly disclose wherein, when the control unit (3) comprises the active code library and selection means, the determination step comprises the selection by the control unit (3) of the appropriate active code in the library, however, “DAN” disclosed that the active code is selected based on the function required before being sent to the active node (see at least page 611, left column).

Claim 11 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 12, “AAPA” and “DAN” disclosed a method according to claim 8.

“AAPA” did not expressly disclose wherein, when the control unit (3) comprises active code generation means, the determination step comprises the generation of the appropriate active code on the fly by the control unit (3), however, “DAN” did disclose these limitations (see at least page 611, left column, specifically regarding the steps described in Figure 2)

Claim 12 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Conclusion

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider the entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and nonpreferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PTO-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C. Neurauter, Jr./
Primary Examiner, Art Unit 2143